

Appln. No. 10/645,266  
Amendment Dated May 1, 2006  
Reply to Office Action of December 1, 2005

### REMARKS

Applicants respectfully request the entry of the foregoing amendments.

Claims 2 and 7 have been canceled and the subject matter incorporated into Claim 1. Claim 12 has been canceled and the subject matter incorporated into Claim 8.

Amended Claim 1 is directed to:

A lubricant composition exhibiting enhanced load-carrying capacity and oxidative/corrosion stability said lubricant composition comprising a major portion of:

- a) a synthetic ester based stock is the esterification product of an aliphatic polyol containing 4 to 15 carbon atoms and from 2 to 8 esterifiable hydroxyl groups reacted with a carboxylic acid containing from 4 to 12 carbon atoms;
- b) 3-(di-isobutoxy-thiophosphonylsulfanyl)-2-methyl-propionic acid (DITMPA); and
- c) a yellow metal passivator selected from the group consisting of tolutriazole, benzotriazole and combinations thereof.

Claims 1, 2, and 4-13 were rejected under 35 U.S.C.102(b) as being anticipated by Camenzind et al (US 5,922,657).

Applicants respectfully traverse this rejection.

Camenzind from column 2, line 53 to column 3, line 25 discloses a vast range of different types of different compounds which can be employed as a lubricant base stock. Synthetic ester-based lubricants are merely one example of a base stock which may be used.

Nowhere in the disclosure of Camenzind is DITMPA specifically disclosed. In this regard, it should be noted that the specification in column 2, lines 13-23, states that "with particular preference"  $R_3$  is hydrogen, i.e., the preferred compounds do not include DITMPA.

Hence, the person skilled in the art would have to select an embodiment which is neither specifically disclosed nor considered preferable in order to arrive at the subject matter of Applicants' claimed invention.

Although tolutriazole and benzotriazole are disclosed in Camenzind, they are merely two compounds in a list containing over 30 different options.

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A person skilled in the art would be faced with having to make three different selections in order to arrive at the subject matter presently claimed in Claims 1 and 8. given the necessity of such specific selections, it is respectfully submitted that the present claims are novel over the disclosure of Camenzind.

Furthermore, it is clear from the results, for example, in Table 3 on page 11 of the specification that the compositions of the present invention provide surprisingly good results, which would not be expected from the disclosures of Camenzind.

More specifically, Examples 2, 3, 8, 9, and 10 demonstrate that where a combination of DITMPA and tolutriazole or benzotriazole is added to a lubricating composition, the amount of copper loss is significantly reduced compared to other compositions where DITMPA is not present, or alternatively is replaced by another compound, for example DMTD or SFAE, which are both known alternatives used in the art.

In addition, reference is made to Table 1 on page 9 of the specification, where it can be seen that the compositions of Examples 2 and 3 demonstrate the highest load-carrying capacity when compared with Examples 1 and 4 to 6 (please note that Example 7 is a military specification, and therefore its composition is unknown).

Further, reference is made to Table 2 on page 10, where it can be seen that the compositions of Examples 2 and 3 are the only ones which demonstrate improved performance when compared to the composition of Example 1.

Camenzind does not specifically disclose the use of DITMPA, and therefore cannot be considered to teach or suggest the benefits of combining DITMPA with a yellow metal passivator with the surprising result of significantly improved corrosion/oxidative stability.

In this regard, the disclosure of Camenzind is concerned with use in "internal combustion engines, for example in motor vehicles fitted with, for example engines of the Otto, diesel, two-stroke Wankel or orbital type". Hence the disclosure of Camenzind is concentrated solely on FCG transmission tests and does not disclose any results for oxidation/corrosion stability, which properties are considered highly important in the preparation of turbine oils. Accordingly, nothing in the disclosure of Camenzind teaches, nor suggests, the benefits attained in the present invention as disclosed in Tables 2 and 3, nor the results attained in the Hot Liquid Process simulator test, US Navy Vapor Phase Coking test or Cyclic Coker Mister test.

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It is respectfully submitted that Claims 1, 2, and 4-13 are neither anticipated by nor obvious over Camenzind.

Claims 3 and 14 were rejected under 35 U.S.C.103(a) as being unpatentable over Camenzind et al (US 5,922,657) in view of Ashcraft, Jr. et al (US 5, 503,761).

Technical pentaerythritol is neither disclosed nor suggested in Camenzind. Given the surprisingly good results obtained with the compositions of the present invention, as discussed above, and the necessity for making three choices from the lists of compositions in Camenzind to arrive at Applicants' claimed subject matter, it is submitted that it would not be obvious to one skilled in the art to choose technical pentaerythritol, which is neither disclosed nor suggested in Camenzind, to arrive at the subject matter of Claims 3 and 14.

It is clear that a person skilled in the art, even with the knowledge of Camenzind alone or in combination with Ashcraft, would not arrive at the specific compositions of the present invention and would not expect the surprising benefits seen with regard to oxidative/corrosion stability and stability under extreme conditions.

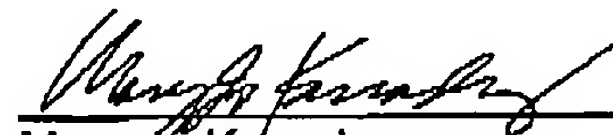
For the reasons stated above, it is submitted that one skilled in the art would not be led to Applicants' claimed invention by the disclosure of Camenzind alone or in combination with Ashcraft and that the claimed invention is not obvious over Camenzind alone or in combination with Ashcraft.

In view of the foregoing amendments and remarks, Applicants respectfully submit that the application is in condition for allowance.

Reconsideration, allowance of all claims, and passage of the application to issue are respectfully requested.

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